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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,663	03/09/2004	Michael E. Daniels	ZIM0409	3929

7590 02/08/2007
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EXAMINER

RAMANA, ANURADHA

ART UNIT	PAPER NUMBER
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3733

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/797,663

Applicant(s)

DANIELS, MICHAEL E.

Examiner

Anu Ramana

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-8,10,12,22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22 and 23 is/are allowed.
- 6) ☒ Claim(s) 1,3,5-8,10 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/2/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 29, 2007 has been entered.

Claim Objections

Claims 1 and 3 are objected to because of the following informalities.

In line 7 of claim 1, the limitation, "the shoulder of the elongated member seating in the through channel," is vague. It appears that Applicant is trying to claim that the shoulder is seated in the through channel.

In line 1 of claim 3, "the first portion" should be "a first portion" to correct a minor typographical error.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Fabian et al. (US 4,936,853).

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Fabian et al. disclose a modular knee prosthesis including: a tibial plate 20; a tibial insert 30 removably engaged with the superior surface of the tibial plate 20; an elongate member 14 having an internally threaded socket with a turn of the internal thread constituting a radially projecting shoulder, the shoulder seated in a through channel defined by the plate and the insert; and a screw 35 extending through the insert and threadably engaged with the elongated member (Fig. 5, col. 3, lines 49-68 and col. 4, lines 1-53).

Using an alternate interpretation, claims 1, 3 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Fabian et al. (US 4,936,853).

Fabian et al. disclose a modular knee prosthesis including: a tibial plate 20; a tibial insert 30 removably engaged with the superior surface of the tibial plate 20; an elongate member 14 having an internally threaded socket and a cruciate cross section wherein flanges 15 and 16 form radially projecting shoulders, the shoulders seated in a through channel defined by the plate and the insert at a superior end of the elongate member; and a screw 35 extending through the insert and threadably engaged with the elongated member (Figs. 2, 2A and 5, col. 3, lines 49-68 and col. 4, lines 1-53).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-7, 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fabian et al. (US 4,936,853) in view of McCue et al. (US 6,506,216).

Regarding claims 5-7 and 12, Fabian et al. disclose all elements of the claimed invention except for: the base having protuberances including a first generally keel-like portion wherein the first keel-like portion extends radially outwardly relative to the

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through-channel; and a second generally keel-like portion extending radially outwardly relative to the through-channel at an angle of about 180 degrees from the first generally keel-like portion.

McCue et al. teach providing wing elements or "keel-like portions" 26 on the keel or "base" 24 of a tibial tray or plate 12 at varying angles for fixation and positional stability of the prosthesis (Fig. 2 and col. 3, lines 29-36).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided wing elements 26, as taught by McCue et al., in the Fabian et al. prosthesis, for fixation and positional stability.

It is also noted that Applicant has not disclosed a criticality to the angle between the keel-like portions (page 9, lines 7-8).

Accordingly, it would have been an obvious matter of design choice to a person of ordinary skill in the art to provide the first and second keel-like portions in the prosthesis of the combination of Fabian et al. and McCue et al., at an angle of about 180 degrees because Applicant has not disclosed that providing a specific angle between the first and second keel-like portions provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected the prosthesis of the combination of Fabian et al. and McCue et al. and applicant's invention, to perform equally well with either the angle taught by McCue et al. or the claimed "about 180 degrees" because both angles would perform the same function of fixing the tibial plate to the proximal tibia.

Regarding claim 10, it would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to have constructed the socket in the prosthesis of the combination of Fabian et al. and McCue et al. with a hexagonally-shaped portion, since applicant has not disclosed that this solves any stated problem, or is anything more than one of numerous shapes or configurations a person of ordinary skill in the art would find obvious for the purpose of providing. In re Dailey and Eilers, 149 USPQ 47 (1966).

Response to Arguments

Applicant's arguments submitted under "REMARKS" in the response filed on January 29, 2007 have been fully considered.

Applicant's arguments with respect to the rejection of claims 1, 3 and 8 under 35 U.S.C. 102(b) as being anticipated by Fabian et al. are not persuasive for the following reason.

It is the Examiner's position that the limitation "*shoulder of the elongated member seating in the through-channel*" is disclosed in the embodiment of Fig. 2. When the tapered portion 17 is in the through-channel a turn of the internal thread or "radially projecting shoulder" is seated in the through channel.

Alternatively, in the embodiment of Figs. 2, 2A, flanges 15 and 16 form shoulders where they meet with the elongated member. At a superior end of the shaft of the elongated member, once such shoulder would be seated in the through channel.

It is noted that the limitation, "the elongated member extending through the tibial plate and base superior-distally" only requires that a portion of the elongated member extend through the tibial plate and base.

Allowable Subject Matter

Claims 22 and 23 are allowed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached on Monday through Friday between 8:00 am to 5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR
February 3, 2007

A handwritten signature in black ink, appearing to read "Anuradha Ramana". The signature is written in a cursive, flowing style.